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|------------------------|-------------|-----------------------|---------------------|------------------|
| 09/849,504             | 05/04/2001  | William Donovan Quigg | 33582-8001US1       | 8692             |
| 25096                  | 7590        | 12/03/2008            | EXAMINER            |                  |
| PERKINS COIE LLP       |             |                       | LASTRA, DANIEL      |                  |
| PATENT-SEA             |             |                       |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                        |
|------------------------------|------------------------|------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>    |
|                              | 09/849,504             | QUIGG, WILLIAM DONOVAN |
|                              | <b>Examiner</b>        | <b>Art Unit</b>        |
|                              | DANIEL LASTRA          | 3688                   |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 September 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-47 and 49-67 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-47 and 49-67 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-47 and 49-67 have been examined. Application 09/849,504 has a filing date 05/04/2001 Claims Priority from Provisional Application 60/202,583 (05/09/2000).

### **Response to Amendment**

2. In response to Non Final Rejection filed 05/22/2008, the Applicant filed an Amendment on 09/22/2008, which amended claims 1, 11, 18, 22, 26-30 and 61.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 34 and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fail to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus).

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9, 11, 14, 16, 18, 20-32, 34-40, 42, 44-47, 49-54, 56, 61-63, and 65-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozi (WO 96/29263).

As per claims 1, 11, 29 and 61, Ryan teaches:

A computer system for processing a paper product, comprising:

*A processor and a memory including instructions together providing*  
a product order tracker configured to receive a paper product order from a paper purchaser (see Ryan column 9, lines 1-5) to purchase a paper product (see Ryan figure 1, item 17) that is produced by a manufacturer (see column 8, lines 35-40; “postage meter manufacturer”; col 4, lines 5-30; col 13, lines 1-10; ). Ryan teaches a method of manufacturing a production mail system where users purchase paper products where said paper products are the mailpieces (see figure1, items 17, 19, 20).

the paper product including a roll of paper or a plurality of unbound, stacked paper sheets (see Ryan figure 1, item 17; col 6, lines 37-42). Ryan teaches that “the supervisory controller 302 instructs the accumulator module 320 how many successive pages 17a are contained within each document 17. In conventional fashion, the

accumulator module 320 assembles together successive pages 17a all pertaining to a particular document 17, respectively" (see col 6, lines 37-42). Therefore, Ryan teaches that document 17 in figure 1 is a unbound, stacked paper sheet similar to Applicant's specification figure 1, item 160.

a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product (see column 9, line 42 – column 10, line 60)

wherein the promotional material is specifically targeted to a group of people associated with the paper purchaser, the group comprising those people likely to purchase the goods or services of the third party advertiser *and wherein the group of people are likely to view the promotional material on the enclosure for an extended period of time* (see col 10, lines 15-50);

and a paper product tracker configured to provide instructions for creating the enclosure for the paper product (see column 6, lines 50-52), the enclosure having the promotional material of the received promotional material order, the paper product tracker further being configured to provide instructions to enclose the paper product of the received order with the created enclosure, wherein the manufacturer, the paper purchaser, and the third-party advertiser are different entities (see column 8, lines 1-40); and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product (see column 10, lines 14-20; column 13, lines 5-10).

Ryan does not expressly teach that the manufacturer is a paper manufacturer. However, Giacomozi teaches that it is old and well known in the promotion art to print

promotional messages or advertisements on the enclosures or wrappers of manufacture products, such as paper handkerchiefs and where said messages or advertisements are not linked to the contained paper products in said wrappers (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional materials into the wrappers of paper products, as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (i.e. handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan and in view that said paper manufacturers would be motivated to use said payment to lower the selling price of said manufacturers' paper products in order to better compete with other sellers of said paper products. Third party advertisers would pay Giacomozzi's paper manufacturers to include advertisements into the Giacomozzi's paper enclosures using the targeting system taught by Ryan in view that said advertisers would be able to better target their advertisements based upon customers profiles, therefore, increasing the probability that said advertisements would reach their intended target. Commercial users (see Ryan column 9, lines 1-3) would include advertisements into purchase paper products in view that said advertisements would permit said users to purchase said products at a lower price in comparison of purchasing said products without advertisements. Official Notice is taken that it is old and well known in the business art that retailers and/or manufacturers lower the price of their inventory for the purpose of making their inventory more attractive to buyers and therefore, increasing the probability of selling said inventory. It would have been obvious to a person of ordinary skill in the

art at the time the application was made, to know that manufacturers and/or retailers of paper products would include advertisements into wrappers of said paper products in view that the money pay by advertisers for said including would allow said manufacturers and/or retailers to lower the selling price of said products, making their products more attractive to buyers and therefore, increasing the probability of selling said products.

As per claims 2, 14, 16, 18, 20-28, 31, 32, 34-36, 39, 42, 44-47, 49, 52-54, 56, and 62-63, Ryan teaches:

a remuneration tracker configured to track remuneration paid by the third-party advertiser for the promotional material and tracking receipt of remuneration from the paper purchaser for the paper product (see Ryan column 10, lines 7-17).

As per claim 3, Ryan teaches:

an artwork tracker configured to provide instructions for creating a fixed medium that includes the promotional material (see Ryan column 6, lines 50-55).

As per claims 4, 30 and 51, Ryan teaches:

wherein the promotions order tracker is configured to coordinate enclosing the paper product with a particular enclosure based on the content of the promotional material, the identity of the paper purchaser, and/or a location to which the paper product is to be delivered (see column 9, lines 42-55 “address restriction data”; col 13, lines 30-40).

As per claim 5, Ryan teaches:

wherein the promotional material order is a first promotional material order for first promotional material and the third-party advertiser is a first third-party advertiser, and wherein the promotions order tracker is configured to receive a second promotional material order from a second third-party advertiser to place second promotional material on the enclosure (see column 10, lines 54-57).

As per claim 6, Ryan teaches:

wherein the product order tracker is configured to receive a paper product order (see column 1, lines 47-50; col 11, lines 25-60; col 12, line 60 – col 13, line 10) for unbound, stacked sheets of paper and/or a roll of paper.

As per claim 7, Ryan teaches:

wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper (see column 9, lines 42-67) to enclose unbound stacked sheets of paper (see col 6, lines 37-42). Ryan teaches that “the supervisory controller 302 instructs the accumulator module 320 how many successive pages 17a are contained within each document 17. In conventional fashion, the accumulator module 320 assembles together successive pages 17a all pertaining to a particular document 17, respectively” (see col 6, lines 37-42). Therefore, Ryan teaches that document 17 in figure 1 is a unbound, stacked paper sheet similar to Applicant’s specification figure 1, item 160.

As per claim 9, Ryan teaches:

wherein the promotions order tracker is configured to receive an order for an advertisement placed on paper enclosure (see column 9, line 42 – column 10, line 25)

but does not expressly teach that said enclosure is a box configured to enclose the paper product. However, Giacomozzi teaches that it is old and well known in the promotion art to print promotional messages or advertisements on the enclosures or wrappers of manufacture products, such as paper handkerchiefs and where said messages or advertisements are not linked to the contained paper products in said wrappers (see figure 1; abstract). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would use the Ryan's system to print promotional materials into the wrappers of paper products (i.e. paper handkerchiefs), as taught by Giacomozzi in view that third party advertisers would pay the paper manufacturers (i.e. handkerchief manufacturers) for including advertisements into said wrappers, as taught by Ryan.

Claims 37 and 38, Ryan does not expressly teach:

Disposing the promotional material on the enclosure before disposing the paper product within the enclosure or disposing the promotional material on the enclosure after disposing the paper product within the enclosure. However, it would have been obvious to a person of ordinary skill in the art that disposing the promotional material on the enclosure before or after disposing the paper product within the enclosure would be a decision made by the person receiving the promotional material that would not affect the step of inserting promotional material on the enclosure of paper products and therefore, would not patentably distinguish the claimed invention from the prior art.

As per claim 40, Ryan teaches:

wherein providing instructions for disposing promotional material includes providing instructions for printing an advertisement on an external surface of the enclosure (see column 9, lines 42-67).

As per claim 65, Ryan teaches:

instructing another entity to dispose the promotional material on the enclosure (see column 10, lines 54-60).

Claim 66, Ryan teaches:

wherein the product order tracker is configured to receive a paper product order for unbound, stacked, unfolded sheets of papers (see col 11, lines 25-60; col 12, line 60 – col 13, line 10; figure 1, item 17). Ryan teaches that “the supervisory controller 302 instructs the accumulator module 320 how many successive pages 17a are contained within each document 17. In conventional fashion, the accumulator module 320 assembles together successive pages 17a all pertaining to a particular document 17, respectively” (see col 6, lines 37-42). Therefore, Ryan teaches that document 17 in figure 1 is a unbound, stacked paper sheet similar to Applicant’s specification figure 1, item 160.

As per claim 67, Ryan does not expressly teach wherein the paper purchaser manufacturer is an office and the group of people are employees that work in the office. However, Official Notice is taken that it is old and well known in the business art that offices’ employees orders paper products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that offices employees would include advertisements into wrappers of order paper products,

as taught by Ryan in view that said advertisers would subsidy the cost of said paper products.

5. Claims 8, 43 and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Itkonen (US 5,473,863).

As per claims 8, 43 and 57-59, Ryan fails to teach:

wherein the promotions order tracker is configured to receive an order for an advertisement placed on a wrapper configured to enclose a roll of paper. However, Itkonen teaches a method for wrapping a roll of paper, where said wrapper is often printed with advertisement (see column 1, lines 64-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the same method use by Ryan to print advertisements in the enclosure of unbound, stacked paper sheets (see Ryan figure 1, item 17) would be used to print advertisements in the Itkonen's roll wrapper of a roll of paper sheets in view that said wrapper would include promotions that would subsidize the cost of producing and wrapping said paper roll, as taught by Ryan.

6. Claims 10, 33, 41, 55 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Crossman (US 5,035,515).

As per claims 10, 33, 41, 55 and 64, Ryan fails to teach:

wherein the promotions order tracker is configured to receive an order for a coupon placed on or enclosed by the enclosure. However Crossman teaches package

wrappers having detachable coupons (see figure 1). Therefore, It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Ryan would include third party advertisers coupons into a package wrappers, as taught by Crossman in order to offset the cost of producing said products by billing advertisers for said including, as taught by Ryan.

7. Claims 12, 13, 15, 17, 19 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Loeb (US 6,421,652).

As per claims 12, 13, 15, 17, 19 and 50, Ryan fails to teach:

wherein receiving a paper product order includes receiving the order from an intermediate party, with the intermediate party receiving the order from the paper purchaser or a third-party advertiser and tracking receipt of remuneration from the third-party advertiser to an intermediate party for the promotional material. However, Loeb teaches that 60% of all new subscriptions are acquired by third-party service providers (see column 2, lines 10-20). Therefore, it would have been obvious to a person of ordinary skill in the art the time the application was made, to know that Ryan would use intermediary parties (i.e., agents) that would work to bring more customer to order paper products. The intermediary party would be more than willing to serve as an intermediary in the interaction between paper purchasers and advertisers because said intermediary party would receive remuneration from said interaction.

8. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Giacomozzi (WO 96/29263) and further in view of Itkonen (US 5,473,863) and Crossman (US 5,035,515).

As per claim 60, Ryan fails to teach:

wherein the promotional material includes a coupon. However Crossman teaches package wrappers having detachable coupons (see figure 1). Therefore, It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Ryan would include third party advertisers coupons into a package wrappers, as taught by Crossman in order to offset the cost of producing said products by billing advertisers for said including, as taught by Ryan.

#### ***Response to Arguments***

9. Applicant's arguments filed 09/22/2008 have been fully considered but they are not persuasive. The Applicant argues that in direct contrast to both Ryan and Giacomozzi, applicant's technology is related to placing advertisements on enclosures for paper products with the advertisements specifically targeted to a group of people that are likely to be exposed to the paper product but according to the Applicant, Ryan targets advertisements to a single individual. The Examiner answers that Ryan teaches targeting ads to commercial users (see col 9, lines 50-55), targeting ads to a cluster of recipients (i.e. group), where said clustering is based upon geographic location (see col 13, lines 32-34) and furthermore, Ryan teaches that advertisers target an audience (i.e. group of peoples) (see col 3, lines 1-2). Therefore, contrary to Applicant's argument, Ryan teaches targeting to a group of people or recipients.

The Applicant argues that the prior arts do not teach that "the group of people are likely to view the promotional material on the enclosure for an extended period of time" because according to the Applicant, an envelope in Ryan, typically arrives at a recipient address and it is discarded and in Giacomozzi, the handkerchief wrapper, typically sits on a store shelf where it is exposed to unknown group of people. The Examiner answers that the Applicant is arguing about limitation not stated in the claims and not even mentioned in the prior arts. Therefore, anybody (i.e. group of people) that view Ryan and Giacomozzi wrappers for a period of time would view the promotional material for an extended period of time and therefore, contrary to Applicant's argument, the prior arts teach Applicant's claimed limitation.

The Applicant argues that the prior art does not teach claim 65. The Examiner answer that "another entity" is allowing "other advertisers" to restrict ad space (see Ryan col 10, lines 50-67). Therefore, contrary to Applicant's argument, the prior art teaches Applicant's claimed invention.

The Applicant argues Ryan teaches that an individual piece of mail is addressed to a single recipient and the advertisements placed on each piece of mail targets only that single recipient. The Applicant further argues that there is nothing in Ryan that teaches that a single letter would be viewed by a group of people or that the sender of the letter is aware of that group so as to target advertisements to them. The Examiner answers that the Applicant is arguing about limitation not stated in the claims. Applicant's claims simply recites "placing promotional material on an enclosure for the paper product, wherein the promotional material is specifically targeted to a group of

people". Ryan teaches placing promotional material on an enclosure for the paper product (see figure 1, items 17 and 20) wherein the promotional material is targeted based upon demographic and/or geographic location of a target audience (see col 10, lines 15-50). Therefore, contrary to Applicant's argument, Ryan teaches Applicant's claimed limitation.

The Applicant argues that one of ordinary skill in the art would not be motivated to modify Ryan's system and print promotional onto Giacomozzi's wrappers because Ryan teaches away from placing promotional material on Giacomozzi's wrappers because, according to the Applicant, in Giacomozzi the advertiser cannot exercise any control over who receives the message. The Applicant further argues, that in Giacomozzi, the message is received by random individuals who either purchase Giacomozzi's handkerchief packages or notice the promotional message on the package and this is, according to the Applicant, the type of advertising Ryan's invention is designed to avoid. According to the Applicant, the Examiner's suggested use of Ryan's system to print promotional material onto Giacomozzi's wrappers contravenes one purpose of Ryan's invention – overcoming the disadvantage of conventional advertising campaigns in which the third party advertiser has no assurance that a target audience would be reached. The Examiner answers that if Giacomozzi would have mentioned anything that disparage the targeting advertisement by user or advertisers' profile, then the Applicant would have had a point. However, Giacomozzi never mention anything that disparage targeting of advertisement. Furthermore, Giacomozzi was used by the Examiner to simply teach that it is old and well known in the promotion art to print

promotional messages or advertisements on the enclosures of manufacture products, where said messages or advertisements are not linked to the contained paper products in said wrappers (see figure 1; abstract). Ryan discloses placing advertisements into the enclosure of paper products (see figure 1, item 17) where said advertisements are targeted based upon users and advertisers' profiles or preferences. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would place advertisements in the Giacomozzi's wrappers if said advertisers would have had control on the type of advertisements that said advertisers would want to advertise and the type of users that said advertisers would want to target (*i.e.* geographic location, age, income), as taught by Ryan in view that said advertisers are paying for said placing and therefore, would like to have control of said placing. Therefore, contrary to Applicant's argument, Ryan does not teach away from placing promotional material on Giacomozzi's wrappers.

The Applicant further argues that Giacomozzi also teaches away from combining his disclosed features with those of Ryan because according to the Applicant, Giacomozzi is directed to displaying promotional messages to the public at large, not message targeted to a specific recipient and Ryan teaches promotional message to a single recipient of the message. Therefore, the Applicant argues that one skilled in the art would not be motivated to combine Ryan with Giacomozzi. The Examiner answers that that examiner used the Giacomozzi reference only to teach that it is old and well known in the promotion art to print promotional messages or advertisements on the enclosures or wrappers of manufacture products, such as paper handkerchiefs and

where said messages or advertisements are not linked to the contained paper products in said wrappers (see figure 1; abstract) and Ryan teaches targeting messages to a target audience based upon said audience demographic and/or geographic location (see col 10, lines 15-55). Therefore, contrary to Applicant's argument, Ryan and Giacomozzi are combinable.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on (571)272-6722. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/  
Examiner, Art Unit 3688  
November 29, 2008